PATENT
Customer No. 22,852
Attorney Docket No. 3495.0193-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#7
10/3/01

In re Application of:

Haroche et al.

Serial No.: 09/628,693

Filed: July 28, 2000

For: DETECTION OF A GENE, vatD, ENCODING AN ACETYLTRANSFERASE INACTIVATING STREPTOGRAMIN

Group Art Unit: 1645

Examiner: Pak

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a Restriction Requirement dated September 11, 2001, the Examiner required restriction under 35 U.S.C. § 121 between the following groups:

I. claims 1-9 and 23-32, drawn to DNA encoding an acetyltransferase, a vector comprising said DNA, a host cell comprising thereof and a method of producing said protein, classified in class 435, subclass 193;

II. claims 10-16, drawn to an acetyltransferase, classified in class 435, subclass 193;

III. claims 17-22 and 33, drawn to antibody against acetyltransferase and an immunological complex comprising said antibody, classified in class 530, subclass 387.9;

IV. claims 34-36, drawn to a method of detecting a bacterium using DNA of Invention I and a kit, classified in class 435, subclass 18;

V. claims 37, drawn to a method of screening an active antibiotic, classified in class 435, subclass 243;

VI. claim 38, drawn to a method of screening for active synthetic molecules capable of penetrating into bacteria, classified in class 435, subclass 243;

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VII. claim 39, drawn to an *in vitro* method of screening for active molecules, classified in class 435, subclass 243; and

VIII. claims 40-41 drawn to a method of detecting a bacterium that harbors the DNA of Invention I, classified in class 435, subclass 243.

Election

Applicants provisionally elect to prosecute Group I, claims 1-9 and 23-32 drawn to DNA encoding an acetyltransferase, a vector comprising said DNA, a host cell comprising thereof and a method of producing said protein, classified in class 435, subclass 193, with traverse.

Traverse

In the Action, the Office states that inventions I-III are patentably distinct because a DNA, protein, and antibody are different compounds, each with its own chemical structure and function, and each having different utilities. It is further stated that Inventions I and (IV-V and VIII) are related as product and process of use and that the inventions can be shown to be distinct if either of both of the following can be shown: (1) the process for using the product as claimed ban be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). Inventions II and (VI and VII) are stated as being patentably distinct because they also are related as product and process of use. Finally, the Office states that the methods of Inventions IV-VIII are patentably distinct as directed to materially different methods employing different products.

Applicants respectfully submit that while the reasons provided by the Office are *factors* in determining whether claims should be examined together, they are not the *only* factors. For example, it is respectfully submitted that the subject matter of all

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pending claims are sufficiently related that a thorough search of the subject matter of any one group of claims would encompass a search for the subject matter of the remaining claims. Thus, a search and examination of the non-elected subject matter with that of Group I would not place a serious additional burden on the Examiner. M.P.E.P. § 803 states that "if the search and examination of the entire application can be made without serious burden, the Examiner must examine it on the merits" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office.

In conclusion, Applicants respectfully request that the Examiner withdraw the restriction requirement and consider all of the pending claims together.

Lastly, for the sake of completeness, Applicants note that page 4 of the Restriction Requirement indicates that Mr. Hultquist was telephoned on August 22, 2001 for the purpose of making an oral election. The Examiner has indicated that this is a mistake and that the call was in fact made to Mr. Kenneth Meyers, Applicants' representative.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Dated: September 28, 2001

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